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January 12, 2006

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Re:	**Application No.:**	**10/603,266**
	Confirmation No.:	**7160**
	Art Unit:	**2613**
	Appellants:	**Jeffery M. Enright, et al.**
	Title:	**System and Method for Capturing and Searching Image Data Associated with Transactions**
	Docket No.:	**D-1112 R2 DIV**

Sir:

Please find enclosed the Appeal Brief of Appellants pursuant to 37 C.F.R. § 41.37 for filing in the above-referenced application.

Please charge the fee required for the Appeal Brief ($500) and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of	**Jeffery M. Enright, et al.**	
Application No.:	**10/603,266**	Art Unit 2613
Confirmation No.:	**7160**	
Filed:	**June 23, 2003**	Patent Examiner Andy S. Rao
Title:	**System and Method for Capturing and Searching Image Data Associated with Transactions**	

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BRIEF OF APPELLANTS PURSUANT TO 37 C.F.R. § 41.37

Sir:

The Appellants hereby submit their Appeal Brief pursuant to 37 C.F.R. § 41.37 concerning the above-referenced Application. This Appeal Brief is in response to the Office Action dated August 17, 2005.

(i) REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

(ii) RELATED APPEALS AND INTERFERENCES

One or more applications may have been appealed that also claim priority to Provisional application 60/103,731 filed October 9, 1998. At present it is believed that no other appeal pertains to the claimed subject matter. However, it is respectfully requested that the Board of Appeals and Interferences ("Board") make its own determination regarding the pertinence of any other application.

Appellants, Appellants' legal representative, and assignee believe that there are no other related appeals or interferences pertaining to this matter.

(iii) STATUS OF CLAIMS

Claims 1 and 68-89 are pending in the Application.

Claims rejected:	1 and 68-89
Claims allowed:	none
Claims confirmed:	none
Claims withdrawn:	none
Claim objected to:	none
Claims canceled:	2-67

Appellants appeal the rejections of claims 1 and 68-89, inclusive. These rejections were in the Office Action ("Action") dated August 17, 2005.

Additional Comment

It has come to the attention of the Appellants that claims 80-85 contain minor obvious typographical errors. Claim 80 should end with a period. Step "i" referred to in each of claims 81-85 should instead read as step "h". Permission is hereby granted to the Office to make these changes by Examiner's Amendment. Appellants respectfully submit that since these issues have been resolved they should have no bearing on decision.

(iv) STATUS OF AMENDMENTS

The non-final Action dated August 17, 2005 reopened prosecution following payment of the Issue Fee.

No final rejection is pending. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

(v) SUMMARY OF CLAIMED SUBJECT MATTER

Concise explanations of exemplary forms of the claimed invention:

For reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

With respect to independent claim 1

An exemplary form of the invention is directed to a method. For example, note the description of Figure 13. The method comprises receiving a check into an automated banking machine (e.g., ATM 228, 332; Specification page 58, lines 2-4) including a cash dispenser (e.g., 20). Also see page 20, lines 16-21; and page 75, line 17 to page 76, line 5. The method further comprises capturing an image including indicia on the received check (e.g., page 41, lines 11-12) through operation of an imaging device (e.g., 230, 40, 334) in the machine (e.g., page 58, lines 1-15). The method also comprises operating a computer (e.g., 232) in operative connection with the imaging device (e.g., 230) to produce a markup language document (accessible via network 234; network documents discussed for example at page 24, lines 5-6) corresponding to indicia on the check (e.g., page 41, lines 11-12; page 59, lines 2-4). Also see page 50, line 19 to page 51, line 2; and page 58, lines 1-15. Further description related to the exemplary form of the invention may be found, for example, at pages 20-111 and Figures 1-85.

With respect to independent claim 86

Another exemplary form of the invention is directed to an apparatus. Support in the disclosure for like reference numerals has previously been provided. The apparatus includes an automated banking machine (228, 332) including at least one user input device (e.g., 56, 60)(e.g., page 25, lines 20-22), a cash dispenser (20), a document imaging device (40, 230, 334) and at least one computer (232) in operative connection with the at least one user input device, cash dispenser and document imaging device. The at least one computer is selectively operative responsive to user inputs to the at least one input device (56, 60) to cause the cash dispenser (20) to operate to dispense cash from the machine (228, 332), to cause at least one image of a check to be captured through operation of the document imaging device (40, 230, 334), and to produce at least one markup language document corresponding to at least a portion of the at least one image. Further description related to the exemplary form of the invention may be found, for example, at pages 20-111 and Figures 1-85.

With respect to independent claim 87

Another exemplary form of the invention is directed to an apparatus. Support in the disclosure for like reference numerals has previously been provided. The apparatus includes a check analysis terminal (e.g., 52, 236) (e.g., page 25, lines 14-17, page 58, lines 17-22). The terminal includes at least one computer (54), at least one input device (58, 60), at least one display device (e.g., 62, 296) and at least one data store (e.g., 56, 238) in operative connection with the at least one computer (e.g., page 25, lines 14-20, page 58, lines 1-22). The at least one data store (56, 238) includes check transaction data corresponding to at least one image captured

of at least a portion of a check during a check receiving transaction at a cash dispensing automated banking machine (e.g., page 40, lines 1-15, page 58, lines 1-15; page 72, lines 6-18). The at least one computer is operative to receive additional check transaction data in at least one markup language document, and to cause received check transaction data to be stored in the at least one data store (e.g., page 50, lines 19-22; page 51, lines 3-18; page 52, line 4 to page 53, line 21; page 58, lines 1-15; page 59 line 1- page 61, line 10). Additionally, the at least one computer is operative responsive to at least one input to the at least one input device (58, 60) to cause a visual representation (e.g., 298, 300, 302, 304) corresponding to stored check transaction data to be output through the at least one display device (62, 296) (e.g., page 61, lines 18-21, page 72, lines 6-18). Further description related to the exemplary form of the invention may be found, for example, at pages 20-111 and Figures 1-85.

(vi) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented in this appeal are:

1). Whether claims 1, 68-70, and 72-89 are unpatentable pursuant to 35 U.S.C. § 103(a) over Gustin (US 5,897,625) in view of Anderson, et al. (US 6,209,095) (hereinafter "Anderson").

2). Whether claim 71 is unpatentable pursuant to 35 U.S.C. § 103(a) over Gustin in view of Anderson and Cook (US 5,860,068).

(vii) ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

Evidence of record must teach or suggest the recited features. An assertion of knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). Patentability determination must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action requiring appeal does not meet these burdens.

Again, for reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be simply referred to as "a". Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

The Claims Are Not Obvious Over
Gustin in view of Anderson

Claims 1, 68-70, and 72-89 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gustin in view of Anderson.

The Action admits that Gustin does not teach or suggest producing a markup language document, especially a markup language document corresponding to indicia on a check. The Action alleges that Anderson teaches generating financial markup language documents in order to provide tagged structures of checks. The Action alleges that it would have been obvious to incorporate the Anderson teaching of using a financial services markup language (FSML) to generate the tagged files of Gustin's scanned checks to ensure verification for electronic transactions across the Internet.

Appellants traverse the rejections on the grounds that Appellants' claims recite features and relationships which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' recited invention. Nor do the references teach or suggest the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The features and relationships recited in Appellants' claims patentably distinguish over the applied references.

The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The Office has not established a *prima facie* showing of obviousness. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged to have produced the recited invention. The applied references are devoid of any teaching, suggestion, or motivation to modify Gustin in view of Anderson to produce the recited invention. Even if it were somehow possible (which it isn't) to modify Gustin with the teaching of Anderson as alleged, the record still would not factually support a *prima facie* conclusion of obviousness. Thus, Appellants respectfully submit the rejections are improper and should be withdrawn.

Gustin

The disclosure of Gustin is silent as to the exact details concerning complete and enabling operation of the system. Therefore, the description of any portion of Gustin herein or any comments directed thereto shall not be construed as an admission by Appellants that Gustin's system is enabling or is capable of achieving any of Appellants' recited features.

Gustin is directed to an automated document cashing system that can capture an image of a negotiable instrument (e.g., a check) and recognize the authored signature as well as the amount written thereon. The system includes an ATM-like machine (10) (hereinafter "ATM"). The

cashing of a check is achieved by the ATM's ability to read the cursive signature of the drawer or maker of the check, to *verify the cursive signature as being that of a profiled or qualified user who has inserted his ATM card into the machine*, and to read the amount on the cursive legal line on the check and the dollar amount line (the CAR line) as well as the bank and account identifications printed in magnetic ink characters on the check (col. 4, lines 9-16). As best understood, Gustin only permits a previously profiled user for whom signature information is stored in the ATM to deposit/cash a check that was drafted by that profiled user. That is, a profiled user can only deposit/cash their own personal check.

Gustin's process for depositing/cashing a check is described at col. 16, line 29 to col. 17, line 33. The process comprises:

Having the user's signature on record at ATM.

User inserts card at ATM.

User inputs the check amount at ATM.

Check is scanned by ATM and the images stored on a magnetic medium in TIFF format.

Check is confirmed as valid by ATM (*discussed in more detail below).

ATM uses banking network to determine if the check's account has a sufficient balance to enable the cashing thereof (col. 16, lines 44).

If there is a sufficient balance, then ATM deposits/cashes the check and prints a receipt.

Gustin's process for confirming a check as valid by the ATM is described at col. 12, line 28 to col. 14, line 10. The process comprises:

ATM's Quickstrokes character recognition software analyzes the scanned check image to determine characters in each of signature line, amount line, and courtesy amount.

The character results are used by the ATM's verification software to evaluate (compare) the signature on the signature line (determined by Quickstrokes) with the user's profile signature on record (col. 17, lines 1-8; ATM processor 21, col. 8, lines 43-49, col. 15, lines 42-44).

The character results are also used by the ATM's verification software to determine if both check amounts (determined by Quickstrokes) match the amount inputted by the user. If the (two) signatures match and the (three) amounts match, then the check is confirmed as valid by the ATM.

Claim 1

Appellants respectfully submit that the Office misinterprets the Gustin reference. For example, Gustin does not teach or suggest that the TIFF image file "is generated as a confirmation means to send over the banking network" as alleged by the Office, especially at relied upon col. 13, lines 39-55. Gustin's TIFF image file is *not* sent over the banking network. Nor does Gustin have any need to send the TIFF image file over a banking network. Gustin's TIFF image file is only used locally at the ATM in verifying the signature and the check amount.

In Gustin an image file is magnetically stored locally in the ATM on a magnetic recording medium in a TIFF format and is provided with an identifying tag so that the image file (step 440 in FIG. 14) can be later accessed if necessary (col. 13, lines 1-4; claim 31). In Gustin the back of a check is scanned so the endorser's signature can also be stored in the image file. In Gustin, as is

conventional in the art, a locally stored check image can be later retrieved (if necessary) at the ATM, and reviewed to resolve any dispute regarding the transaction.

Gustin teaches that only a representation of the "signature verification" (as well as the amount) is forwarded to the bank network for payout confirmation (col. 13, lines 44-47; col. 14, lines 6-8; col. 12, lines 58-61). That is, the signature is verified at the ATM, then a notification of the ATM's ability to accomplish this signature verification is sent to the bank network. There is no teaching or suggestion that the signature is sent over the bank network.

Gustin is silent as to how the "signature verification" is represented. Apparently an indication of signature verification is sent (along with the check amount) in a request for confirmation (by a bank in the banking network) that the checking account has sufficient funds to cover the check amount (col. 16, lines 43-45). Without bank confirmation from the bank the check is rejected (col. 13, lines 47-50). If the bank provides a message to the ATM that includes such confirmation, the ATM magnetically stores the check at the ATM, prints a receipt, and informs the banking network that the transaction at the machine level has been completed (col. 13, line 51 to col. 14, line 10). Gustin does not teach or suggest sending a check image (especially one stored on a magnetic recording medium at the ATM) over a banking network, as alleged and relied upon by the Office. Because the rejection is based on this false premise, the rejection is not legally valid.

The references, taken alone or in combination, do not teach or suggest operating a computer in operative connection with an imaging device of an automated banking machine to produce a markup language document corresponding to indicia on a check received in the machine. The Action admits that Gustin does not teach or suggest producing a markup language

document corresponding to indicia on a paper check received in an automated banking machine. That is, the Office admits that Gustin does not teach or suggest step (c) of claim 1.

Anderson (like Gustin) also does not teach or suggest recited step (c) of claim 1. Anderson cannot alleviate the admitted and additionally noted deficiencies of Gustin, as he does not teach or suggest the recited features which are not found in Gustin.

Anderson is directed to creating and processing completely electronic documents, such as electronic checks. Anderson (unlike Gustin) does not use tangible paper checks. Nor does Anderson (or Gustin) convert paper checks to electronic checks. Anderson likewise has no need of Appellants' recited imaging device or capturing an image of a check electronically. Anderson is non analogous to imaging, check imaging, or for capturing a check image electronically. Anderson's special "FSML" language documents are not produced responsive to a computer/imaging device. Instead, Anderson's documents are initially created electronically. Furthermore, Anderson requires use of a special language (i.e., FSML), special hardware (90, 92, 94, 96, 69, 71), and special software (102, 104; col. 24, line 51 to col. 25, line 27) to create and use his electronic checks (Figures 3 and 4).

Since Anderson does not use tangible checks, Anderson cannot meet any of the recited steps of claim 1. Nor can Anderson alleviate the admitted deficiencies in Gustin with regard to teaching or suggesting anything in the nature of step (c) as recited in claim 1. Thus, the Office has not established a *prima facie* case of obviousness.

Nor would it have been obvious to have modified Gustin with the teachings of Anderson to have produced the recited invention. Since neither reference teaches nor suggests Appellants' recited step (c), any combination of features of these references would still result in the absence

of recited step (c). Thus, it would not have been obvious to one having ordinary skill in the art to have modified Gustin with the teaching of Anderson as alleged to have produced the recited invention.

Furthermore, Anderson teaches that in his system a personal check (74) is electronically created by a person (e.g., payer 12) manually using a workstation (90) (col. 23, lines 42-45; col. 24, lines 51-54). Gustin's system is automated, not manual. It is unclear how a person in Anderson (away from their workstation) could access the interior of Gustin's ATM to manually create an electronic check or a tagged file, as apparently alleged by the Office.

Additionally, Gustin's TIFF files are bit mapped image files. The Office has not shown that Anderson's unique FSML language documents are structurally and functionally compatible with Gustin's system. There is no evidence of record that Anderson's unique FSML language documents are usable by Gustin. Thus, the allegation by the Office that it would be obvious to incorporate Anderson's unique FSML language documents in Gustin is without basis.

Modification of Gustin's explicit teaching in the manner alleged by the Office would destroy the disclosed and desired utility and operability of the Gustin teaching. That is, the alleged modification to Gustin would render the reference inoperable for its intended and desired purpose. For example, as previously discussed, Anderson's system does not use or need a paper check, an imaging device, or capturing a check image. Nor does Anderson (or Gustin) teach, suggest, or provide any means for converting Gustin's paper checks to Anderson's electronic checks. There is no teaching or suggestion whatsoever in the references, of any structure or ability to convert Gustin's paper checks to Anderson's electronic checks, especially using check

imaging. The rejection is invalid as it ignores that there is this missing critical link between Gustin's paper checks and Anderson's non analogous electronic checks.

Even if it were somehow possible (which it isn't) for Gustin to use Anderson's teaching, a check imaging device would no longer be needed in Gustin. That is, the alleged modification of Gustin with the teachings of Anderson would at least result in the removal of the (now unnecessary) imaging device (55) from Gustin. However, because an imaging device is actually recited, the modification would not have produced the recited invention.

Further, an obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the modified (Gustin) reference. In the current situation the alleged modification would at least render Gustin devoid of his previously necessary imaging device. Note *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1598-99 (Fed. Cir. 1988). Again, the Office has not presented a *prima facie* showing of obviousness.

Even if it were somehow possible (which it isn't) for Gustin's Tagged Image File Format (TIFF) files to be generated using Anderson's unique FSML language, as proposed in the Action, such image files still would not be sent by Gustin over the banking network, as alleged and relied upon in the basis for the rejection. That is, Gustin has no need or desire to send any type of image file over the banking network. As previously discussed, Gustin's TIFF image files remain locally stored in the ATM. Gustin's TIFF files are *not* sent out over the banking network in carrying out a transaction. Rather, Gustin's check images are magnetically stored locally *in* the ATM (Gustin's claim 31) on a tangible magnetic recording medium and are tagged so they can be later accessed (via their tag) if necessary (col. 13, lines 1-4). Further, Gustin would use

conventional transaction communication formats, not communication via image files. Thus, the alleged motivation (to enable electronic transactions across the Internet) provided by the Office for modifying Gustin with Anderson's unique FSML language is unreasonable and without merit. It follows that the record is devoid of the requisite proper motivation for reference modification and claim rejection.

For reasons previously discussed, Gustin has no need of sending a check image, especially across the Internet (as alleged by the Office). Nor does Gustin have any need of sending an electronic check (like Anderson's check) across the Internet. It follows that Gustin has no need of a markup language document, especially for web browser and Internet use as alleged by the Office.

The only suggestion for the recited features and relationships is found in Appellants' own novel disclosure. It follows that the rejections are based solely on hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The combination of features in Gustin with features of Anderson alleged by the Office, would destroy Gustin's ability to function as Gustin requires. Therefore, the alleged combination is not enabling to one of ordinary skill in the art. A rejection based on an alleged combination of features in multiple references that clearly does not produce an enabled form of what is specifically recited in the claim, is not a proper rejection. *In re Kumar*, Case No. 04-1074 (Fed. Cir. August 15, 2005).

Nothing in any cited art discloses, suggests or enables producing a markup language document corresponding to indicia on a check that is received in an automated banking machine and imaged by an imaging device therein, as is specifically recited in claim 1. The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to or possible for one having ordinary skill in the art to have modified Gustin with the teaching of Anderson as alleged to have produced the recited invention.

Appellants respectfully submit that they have provided sufficient reasons to refute the Office's allegation of *prima facie* obviousness. Thus, Appellants further respectfully submit that the rejection of claim 1 is improper and should be withdrawn.

Claim 68

The references, taken alone or in combination, further do not teach or suggest the further recited feature of correlating transaction data corresponding to input from a user (from whom the check is received) with a markup language document, through operation of a computer. The Action admits that Gustin does not teach or suggest a markup language document. Anderson is non analogous to the Gustin teaching and the recited invention. Anderson doesn't even receive a tangible check from a user. The Office has not established a *prima facie* case of obviousness.

Claim 69

Claim 69 depends from claim 68/1. The references further do not teach or suggest storing a markup language document *and* the transaction data in a data store in the banking machine. Gustin stores a TIFF image file. Where does Gustin store transaction messages? Gustin has no need or desire to store a markup language document.

In the rejection of claim 1 the Office's (flawed) motivation for using a markup language document in Gustin was to permit transactions across the Internet (away from the ATM). The Office's previously relied upon motivation teaches away from storing the markup language document in the ATM. The Office can't have it both ways. The Office has not established a *prima facie* case of obviousness.

Claim 70

Claim 70 depends from claim 1 and further recites communicating a markup language document from the automated banking machine through operation of a server. The Action relies on Gustin at col. 13, lines 50-55 for a server. However, Gustin does not teach, suggest, or need a server. The Office has not established a *prima facie* case of obviousness.

Claim 72

Claim 72 further recites including *authenticating* information in the markup language document through operation of the computer (e.g., Specification page 28, lines 2-9). The Action relies on Gustin at col. 13, lines 40-45. The relied upon section of Gustin teaches notifying the bank network that the signature has already been authenticated locally at the ATM. Gustin has no reason to send information necessary for authenticating a signature to a bank network after the signature was already authenticated by the ATM. The Office has not established a *prima facie* case of obviousness.

Claim 73

For reasons previously discussed, the references further do not teach or suggest causing a cash dispenser to operate responsive to operation of the at least one computer. It follows that the Office has not established a *prima facie* case of obviousness.

Claim 74

Claim 74 includes the features and relationships recited in claim 70/1. In addition, claim 74 further includes operating a terminal to receive a markup language document (which was communicated from the automated banking machine; claim 70), where the terminal is remotely located from the automated banking machine (e.g., page 9, lines 1-10; page 24, line 10-page 25, line 13).

In Gustin the recognition, analysis, and verification are performed locally at the ATM. Why would a remote terminal be needed?

The Action alleges that Gustin has transmission to a banking network, and that the banking network would include a remote terminal. The Appellants respectfully disagree. There is no evidence of record that Gustin's banking network has or needs a remote terminal. Furthermore, where do the references teach or suggest operating a remote terminal in order to receive a markup language document?

Even if it were somehow possible for Gustin's banking network to have a terminal as alleged, there would still be no teaching, suggestion or enablement of operating the terminal in order to receive a markup language document. Why would an automated banking network (with conventional automated computer-to-computer network communication) need to use/operate a separate terminal?

The rejection is based solely on attempted impermissible hindsight reconstruction of Appellants' claimed invention, and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The Office has not established a *prima facie* case of obviousness.

Claim 75

Claim 75 depends on claim 74/70/1. The references further do not teach or suggest storing image data corresponding to a markup language document in a data store in operative connection with the remote terminal computer. Figure 13 provides an example of data store (238) and remote terminal (236) relationship.

The Action is silent as to where the recited features are allegedly shown in the references. Regardless, the references, taken alone or in combination, do not teach or suggest the recited features. The Office has not established a *prima facie* case of obviousness.

Claim 76

Claim 76 depends on claim 74/70/1. The references further do not teach or suggest that the recited remote terminal includes a browser component, nor processing a markup language document received at the terminal (via operation of the terminal) responsive to operation of the browser component. Where do the references teach or suggest processing a markup language document via operation of a browser at a remote terminal? Gustin does not need a remote terminal, a browser, or a remote terminal with a browser. The Office has not established a *prima facie* case of obviousness.

Claim 77

Claim 77 depends on claim 75/74/70/1. The references further do not teach or suggest analyzing image data (that was stored in a data store) through operation of the remote terminal computer. Gustin at the relied upon section (col. 13, lines 23-25 and 35-40) does not analyze image data at a terminal *remotely* (claim 74) located from the ATM. Conversely, in Gustin the

recognition, analysis, and verification are carried out *locally* at the ATM. The Office has not established a *prima facie* case of obviousness.

Claim 78

Claim 78 depends on claim 77/75/74/70/1. The references further do not teach or suggest analyzing (with a remote terminal) image data for genuineness of check indicia. Again, in Gustin the analysis is carried out locally at the ATM, not at some remote terminal. The Office has not established a *prima facie* case of obviousness.

Claim 79

The references further do not teach or suggest communicating the transaction data and the markup language document from the automated banking machine responsive to operation of a server component. As previously discussed (e.g., claim 70 remarks), Gustin does not teach, suggest, or need a server. Nor has the Office established a *prima facie* case of obviousness.

Claim 80

The references further do not teach or suggest communicating transaction data and a markup language document from the automated banking machine (claim 79) nor operating a remote terminal to receive the communicated markup language document and the transaction data (claim 80). As previously discussed (e.g., claim 74 remarks), the Office has not established a *prima facie* case of obviousness.

Claim 81

Claim 81 depends on claim 80/79/68/1. The references further do not teach or suggest that the recited terminal includes a terminal operator input device. Nor do the references teach or suggest searching the terminal data (received in claim 80) for a selected parameter responsive to

input to the terminal input device. Gustin at the relied upon section (col. 12, lines 55-67) does not teach or suggest the recited features. The operations (e.g., "the software control and operations of the machine") discussed at the relied upon section of Gustin occur at the ATM, not at a terminal remote from the ATM (claim 80). The Office has not established a *prima facie* case of obviousness.

Claim 82

Claim 82 depends on claim 81/80/79/68/1. The references further do not teach or suggest searching terminal data (received in claim 80) for a selected parameter (claim 81) that includes at least one of user name, account number, time, and date (claim 82). Gustin at the relied upon section (col. 12, lines 55-67) does not teach or suggest the recited features. Again, the ATM operation discussed at the relied upon section (col. 12, lines 55-67) of Gustin does not occur at a terminal remote from the ATM (claim 80). The Office has not established a *prima facie* case of obviousness.

Claim 83

Claim 83 depends on claim 80/79/68/1. The references further do not teach or suggest providing a visual representation of the indicia on a check (received in an automated banking machine; claim 1) through an output device of a terminal remote from the machine (claim 80). The ATM operation discussed at the relied upon section (col. 12, lines 30-45) of Gustin does not occur at a terminal remotely located from the ATM. The Office has not established a *prima facie* case of obviousness.

Claim 84

Claim 84 depends on claim 83/80/79/68/1. The references further do not teach or suggest the visual representation outputted at the remote terminal (claim 83) is produced responsive to operation of a terminal browser. The Office has not established a *prima facie* case of obviousness.

Claim 85

Claim 85 depends on claim 80/79/68/1. The references further do not teach or suggest communicating terminal data from the terminal responsive to operation of a terminal server. Gustin at the relied upon section (col. 13, lines 49-56) does not even mention a server, a remote terminal server, or the recited features. The Office has not established a *prima facie* case of obviousness.

Claim 86

For reasons of brevity, Appellants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, neither Gustin nor Anderson, taken alone or in combination, teach or suggest the recited apparatus. Additionally, the references do not teach or suggest a computer of a cash dispensing automated banking machine that is selectively operative, responsive to user inputs, to cause an image of a check to be captured through operation of an imaging device of the machine, and to produce a markup language document corresponding to at least a portion of the captured image. Where do the references teach or suggest a markup language document that corresponds to a captured image of a check?

The Action admits that Gustin does not teach or suggest the recited features and relationships, especially the ability to produce a markup language document corresponding to a check image captured by an imaging device responsive to user inputs to a cash dispensing automated banking machine. Anderson cannot alleviate the admitted deficiencies in Gustin. Anderson is non analogous to imaging, check imaging, or capturing a check image. It follows that Anderson cannot teach or suggest producing a markup language document corresponding to a captured check image.

The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. The references, taken alone or in combination, do not teach or suggest all of the recited features or the apparatus as a whole. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to one having ordinary skill in the art (nor even possible) to have modified Gustin with the teaching of Anderson as alleged to have produced the recited invention.

Claim 87

For reasons of brevity, Appellants' previous remarks regarding the patentability of claim 1 are incorporated herein by reference. For the many reasons already discussed, neither Gustin nor Anderson, taken alone or in combination, teach or suggest the recited apparatus. Additionally, the references do not teach or suggest the recited check analysis terminal. The references do not teach or suggest a check analysis terminal including a computer that is able to receive a markup language document having additional check transaction data, store the received data, and display stored data responsive to input.

The Action apparently alleges that Gustin's device (10) constitutes a check analysis terminal that has a computer (21). The Action additionally admits that Gustin does not teach or suggest having a markup language document "produced". The Action alleges that Anderson teaches using a markup language to "generate" a document. The Action further alleges that it would be obvious to modify Gustin with Anderson's unique FSML language to generate tagged files in order to enable electronic transactions across the Internet.

Appellants respectfully submit that the Office misinterprets the recited claim language. Appellants also respectfully submit that Gustin lacks more of the recited features and relationships than the Action actually admits.

Claim 87 recites, along with other features, a check analysis terminal that has the ability to "receive" check transaction data in a markup language document. That is, claim 87 is directed to receiving a markup language document, not generating and sending a markup language document, as interpreted by the Office. The Office has not addressed all of the recited features, nor provided a prior art showing thereof. On this basis alone the Office has not factually established a *prima facie* case of obviousness.

As previously discussed, Gustin's TIFF image file is *not* sent over the banking network, as alleged by the Office. Nor does Gustin have any need to have the ATM *receive* an image file from the banking network. As previously discussed, Gustin's TIFF image file is locally generated at the ATM and only used at the ATM for purposes of verifying the signature and the check amount. The image file is magnetically stored locally in the ATM on a magnetic recording medium in TIFF format (col. 13, lines 1-4; claim 31).

Gustin also has no need or desire to have the ATM receive a markup language document. For the many reasons previously discussed, the systems of Gustin and Anderson are not compatible.

Nor does Gustin have any need or desire to have the ATM receive "additional check transaction data", especially in a markup language document. Gustin already has all of the check data he needs locally to verify a check. Gustin's ATM already has the paper check. What other check data could he receive that is not already on the check?

Nor do the references teach or suggest a check analysis terminal computer that causes received additional check transaction data to be stored. Even if it were somehow possible (which it isn't) to modify Gustin to receive additional data about the check (and receive it in a markup language document), there still would be no teaching or suggestion of storing this received additional data.

It should be recognized that Gustin does not store (nor have any need to store) the bank's confirmation (i.e., a go signal) for payout (which simply confirms that the checking account has a balance greater than the amount indicated; col. 16, lines 43-45). The checking account number and bank ID were already determined and stored by the ATM (col. 12, lines 59-60; col. 13, lines 1-4 and 21-22) prior to requesting the confirmation from the bank. That is, Gustin stores TIFF image files, not transaction-related messages. It follows that even if it were somehow possible (which it isn't) for Gustin to use Anderson's FSML language for sending messages over the Internet, as alleged by the Office, these transaction-related messages still would not have been stored in a data store by Gustin.

Nor has the Office provided any prior art teaching or suggestion of displaying stored check data through a display device of a check analysis terminal. Gustin magnetically stores check image data. However, where does Gustin actually teach or suggest that the image data is retrieved and *displayed at the ATM* (i.e., the Office's alleged check analysis terminal)? What prevents Gustin from storing the images on the magnetic recording medium (or the storage device 23) and then manually carrying the stored images to another site prior to image review? As Gustin is silent regarding the retrieval and viewing of stored images, the rejection is based on pure speculation instead of concrete evidence of record.

Again, the Office has not provided a teaching or suggestion to: modify Gustin to be able to receive a markup language document, especially a markup language document having additional check transaction data; store the received additional data; and display stored check data responsive to input to a check analysis terminal.

The Action admits that Gustin does not teach or suggest all of the recited features and relationships. Anderson cannot alleviate the admitted and additionally noted deficiencies in Gustin. Anderson is non analogous to check transaction data that corresponds to a check image captured during a check receiving transaction at a cash dispensing automated banking machine. Anderson is not directed to a tangible check, check imaging, or data corresponding to the check image.

The record lacks substantial evidence support for the rejection. *In re Zurko*, supra. *In re Lee*, supra. The references, taken alone or in combination, do not teach or suggest all of the recited features or the apparatus as a whole. The Office has not established a *prima facie* case of

obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Gustin with the teaching of Anderson as alleged to have produced the recited invention.

Claim 88

For reasons already discussed, Gustin has no need or desire to use Anderson's markup language to generate a tagged image file, as alleged by the Office. Nor does Gustin have any need or desire to use a web browser or the Internet. Nothing teaches an automated banking machine that produces a markup language document that includes check transaction data corresponding to an image of a check, as recited. Anderson's system is not applicable to images of checks, let alone check data that corresponds to a check image. For the many reasons previously discussed, the systems of Gustin and Anderson are not compatible and the combination thereof not enabling. It would not have been obvious to have modified Gustin with the teaching of Anderson as alleged to have produced the recited invention. The Office has not established a *prima facie* case of obviousness.

Claim 89

The references, taken alone or in combination, further do not teach or suggest the ability to output a visual representation of a stored image of at least a portion of a check through a display device of a check analysis terminal, as recited. The Office has not established a *prima facie* case of obviousness.

Claim 71 Is Not Obvious Over
Gustin in view of Anderson and Cook

Claim 71 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Gustin in view of Anderson and Cook.

The Action (on page 10) admits that Gustin/Anderson does not teach or suggest using XML as a markup language document. The Action alleges that Anderson uses HTML or SGML in generating FSML. The Action further alleges that Cook teaches that XML is similar to HTML and SGML. The Office concludes that it would have been obvious to develop Anderson's FSML using the XML format, and thus use Anderson's FSML for further generating tagged documents.

Claim 71

Claim 71 depends on claim 1. The references do not teach or suggest a produced markup language document (corresponding to indicia on a check received in an automated banking machine and imaged therein by an imaging device) comprising an XML document.

Cook cannot alleviate the admitted and previously noted deficiencies in Gustin/Anderson as he does not teach or suggest the recited features which are not found in Gustin/Anderson.

The Office has provided no teaching or suggestion that Anderson can use HTML or XML. Conversely, Anderson had to develop/invent a completely new markup language (FSML) based on the broad Standard Generalized Markup Language (SGML) to permit financial services via electronic checks. Note Anderson at col. 18, lines 66-67. The Office has provided no evidence that Anderson's unique language (FSML) is similar to or interchangeable with XML. Nor has any evidence been provided that Anderson's unique FSML conforms to the XML format.

Rather, XML and FSML would each have a distinct functionality. Anderson requires the financial language FSML for financial viability, not XML.

The applied references are devoid of any teaching, suggestion, or motivation to modify Anderson in view of Cook to use XML (and then further modify Gustin in view of the modified Anderson to produce the recited invention, as alleged). The Office has provided no basis for using XML in Anderson in place of the specifically developed/invented financial language (FSML).

The Office's attempt to modify Anderson with XML instead of the required FSML would destroy the explicitly disclosed and desired utility and operability of the Anderson teaching. That is, the alleged modification to Anderson would render the reference inoperable for its intended and disclosed purpose. The modification is also not enabling.

Additionally, Gustin's TIFF files are bit mapped image files. The Office has not shown that XML documents are structurally and functionally compatible with Gustin's system. There is no evidence of record that XML language documents are usable by Gustin.

Even if it were somehow possible (which it isn't) for Gustin's tagged (TIFF) files to be generated using XML language, as proposed in the Action, such files still would not be sent by Gustin over the banking network, as alleged by the Office. As previously discussed (e.g., claim 1 remarks), Gustin has no need or desire to send any type of image file over the banking network. As previously discussed, Gustin's TIFF image files remain locally stored in the ATM.

For the many reasons previously discussed, the Office has not established a *prima facie* case of obviousness.

CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in any of the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features of the applied prior art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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(viii) CLAIMS APPENDIX

1. A method comprising the steps of:

(a) receiving a check into an automated banking machine, the automated banking machine including a cash dispenser;

(b) capturing an image including indicia on the check through operation of an imaging device in the machine;

(c) operating at least one computer in operative connection with the imaging device to produce at least one markup language document corresponding to indicia on the check.

68. The method according to claim 1 and further comprising:

d) receiving at least one user input through at least one input device on the automated banking machine from a user from whom the check is received in (a).

e) correlating transaction data corresponding to the at least one user input with the at least one markup language document through operation of the at least one computer.

69. The method according to claim 68 and further comprising:

f) storing the at least one markup language document and the transaction data in at least one data store in the banking machine through operation of the at least one computer.

70. The method according to claim 1 wherein the at least one computer comprises at least one server component, and further comprising:

d) communicating the at least one markup language document from the automated banking machine responsive to operation of the at least one server component.

71. The method according to claim 1 wherein in (c) the at least one markup language document comprises an XML document.

72. The method according to claim 1 and further comprising:

d) including authenticating information in the at least one markup language document through operation of the at least one computer.

73. The method according to claim 1 and further comprising causing the cash dispenser to operate responsive to operation of the at least one computer.

74. The method according to claim 70 and further comprising:

e) operating a terminal remote from the automated banking machine, to receive the at least one markup language document.

75. The method according to claim 74 wherein the terminal includes at least one terminal computer and further comprising:

f) storing image data corresponding to the at least one markup language document in at least one data store in operative connection with the terminal computer.

76. The method according to claim 74 wherein the terminal includes a browser component, and further comprising processing the at least one markup language document responsive to operation of the browser component.

77. The method according to claim 75 and further comprising:

g) analyzing the image data through operation of the terminal computer.

78. The method according to claim 77 wherein in (g) the image data is analyzed for genuineness of at least a portion of the indicia on the check.

79. The method according to claim 68 wherein the computer comprises at least one server component, and further comprising:

f) communicating the transaction data and the at least one markup language document from the automated banking machine responsive to operation of the at least one server component.

80. The method according to claim 79 and further comprising:

g) operating a terminal remote from the automated banking machine including at least one terminal computer to receive the at least one markup language document and the transaction data;

81. The method according to claim 80 wherein the terminal includes at least one terminal operator input device, and further comprising:

i) searching the terminal data for at least one selected parameter responsive to at least one input to at least one terminal input device.

82. The method according to claim 81 wherein in (i) the at least one selected parameter includes at least one of user name, account number, time and date.

83. The method according to claim 80 wherein the terminal includes at least one output device, and further comprising:

i) providing a visual representation of the indicia on the check through the output device.

84. The method according to claim 83 wherein the at least one terminal computer includes at least one terminal browser component therein, wherein in (i) the visual representation is produced responsive to operation of the at least one terminal browser component.

85. The method according to claim 80 wherein the at least one terminal computer includes a terminal server component and further comprising:

i) communicating at least a portion of the terminal data from the terminal responsive to operation of the terminal server.

86. Apparatus comprising:

an automated banking machine including at least one user input device, a cash dispenser, a document imaging device and at least one computer in operative connection with the at least one user input device, cash dispenser and document imaging device,

wherein the at least one computer is selectively operative responsive to user inputs to the at least one input device to cause the cash dispenser to operate to dispense cash from the machine and to cause at least one image of a check to be captured through operation of the document imaging device and to produce at least one markup language document corresponding to at least a portion of the at least one image.

87. Apparatus comprising:

a check analysis terminal,

wherein the terminal includes at least one computer,

wherein the terminal includes at least one input device,

wherein the terminal includes at least one display device,

at least one data store,

wherein the at least one data store includes check transaction data corresponding to at least one image captured of at least a portion of a check during a check receiving transaction at a cash dispensing automated banking machine,

wherein the at least one data store is in operative connection with the at least one computer,

wherein the at least one computer is operative to receive additional check transaction data in at least one markup language document,

wherein the at least one computer is operative to cause received check transaction data to be stored in the at least one data store, and

wherein the at least one computer is operative responsive to at least one input to the at least one input device to cause a visual representation corresponding to stored check transaction data to be output through the at least one display device.

88. The apparatus according to claim 87 and further comprising

an automated banking machine,

wherein the automated banking machine includes a cash dispenser operative to cause cash dispensing,

wherein the automated banking machine is operative to receive at least one check,

wherein the automated banking machine includes an imaging device operative to capture during a check receiving transaction at least one image of at least a portion of a check,

wherein the automated banking machine includes at least one computer in operative connection with the cash dispenser and the imaging device,

wherein the at least one computer is operative to produce at least one markup language document including check transaction data, wherein the check transaction data corresponds to the at least one image of at least a portion of a check.

89. The apparatus according to claim 87 wherein the visual representation includes at least one image of at least a portion of a check.

(ix) EVIDENCE APPENDIX

(None)

(x) RELATED PROCEEDINGS APPENDIX

(None)